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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,366	01/25/2002	Gerard Malle	2350-94	7627

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EXAMINER	
TRAN, SUSAN T	
ART UNIT	**PAPER NUMBER**
1615	

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/055,366	Applicant(s) MALLE ET AL.	
	Examiner Susan Tran	Art Unit 1615	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 7-16* is/are rejected.

7)☒ Claim(s) *5 and 6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of applicant's Amendment filed 01/25/02.

Double Patenting

Non-Statutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 6,361,767 ('767) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: method for fixing an active compound (including colorant) on hair keratin fibers comprising steps of reducing the disulphide bonds of the hair keratin with an aqueous reducing agent solution.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,361,767. Although the conflicting claims are not identical, they are not patentably distinct from each other because '767 claims a method for fixing an active compound on hair keratin fibers comprising steps of reducing the disulphide bonds of the hair keratin with an aqueous reducing agent solution. Colorant as active compound is found in claim 1. The fiber depth is found in claims 1 and 5. The percent amount of cystine is found in claims 5 and 6. Phosphine formula is found in claim 7. Claim 1 of the application recites the limitation "fixing at least one active compound", and the active compound can be one of the compound recites in claim 14, which includes colorant. Therefore, if colorant were selected, one of ordinary skill in the art would expect the same method of fixing a colorant on hair keratin fibers results from the use of the instant invention given the claims of '767. There are no unusual and/or unexpected results, which would rebut prima facie obvious. As such, the instant claims would have been obvious given the claims of '767, which set out a similar method of fixing a colorant on hair keratin fibers using the same materials, steps, and conditions as claimed herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected in the use of the phrase "reducing the disulphide bonds of the hair keratin with a view to generating reactive sites". It is unclear as to what is being used to reduce the disulphide bonds? Is it the reducing agent? Further clarification is requested.

Claim 9 recites the limitation "formula (I)" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend the formula number in claim 8 to place claim 9 in proper dependent form.

Claim 10 is rejected as being of improper dependent form for failing to further limit the subject matter of a previous claim. It is suggested to amend the claim to place it in proper dependent form.

Regarding claim 12, the phrase "preferably in the range" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention, or just exemplary. See MPEP § 2173.05(d). It is suggested delete one of the ranges.

The term "nucleofugic" in claim 14 is a relative term which renders the claim indefinite. The term "nucleofugic" is not defined by the claim, the specification does not

provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Further clarification is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 7, 11, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al. 3,892,845.

Cunningham teaches a method for adjusting hair comprising applying to the hair combination of keratin disulfide reducing agent and dye reducing agent (column 2, lines 18-66). The time of application ranges from about 15 minutes to 1 hour (column 3, lines 1-20).

Cunningham does not teach the reactive of disulphide bonds on the surface of the fiber to a depth of less than 10 μm. However, since Cunningham uses the same keratin disulfide reducing agent and the same application time to obtain the desired hair color shade without impairing the mechanical properties of the hair (column 1, lines 45-50), it is the position of the examiner that said limitation is clearly inherent. Thus, it would have been obvious for one of ordinary skill in this art to, by routine experimentation optimize Cunningham's composition with the expectation of at least

similar result, because Cunningham teaches a method for fixing hair using the same materials and conditions.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al., in view of Bailey et al. WO 96/03966.

Cunningham is relied upon for the reason stated above. The reference is silent as to the specific active agent in combination with the reducing agent.

Bailey teaches method for styling hair comprising applying to the hair composition comprises reducing agent and hydrophobic groups compound (pages 3-4, and 6). Thus, it would have been obvious for one of ordinary skill to combine Cunningham's composition with the hydrophobic compounds of Bailey, because the references teach the advantageous results in combining reducing agent and active agent such as hydrophobic compound to treat hair fibers.

Claims 8-12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al., in view of Shimura et al. EP 0 331 750.

Cunningham is relied upon for the reasons stated above. The reference is silent as to the teaching of the phosphine formula recited in claim 8. However, Cunningham teaches the exact same phosphine compound recited in claims 9 and 10, *e.g.*, tris-(hydroxyalkyl) phosphine.

Shimura teaches a method for treating hair fibers comprising applying to the hair composition comprising hydroxyalkylphosphine compound having formula (1), other

additives, and pH adjusting agent to obtain pH ranges from 3-7 (pages 3-4). Hence, it would have been obvious for one of ordinary skill to modify Cunningham's composition using the hydroxyalkylphosphine compound in view of the teachings of Shimura, because the references teach the advantageous results in the use of hydroxyalkylphosphine compound for the same purpose, *e.g.*, treating hair fibers.

Claims allowable

Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leon et al. and Karjala are cited as of interest for the teachings of compositions and methods for treating keratinous hair fibers.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600